

REMARKS

Claims 1-7 remain pending in the present Application. Claims 1, 2, and 5 have been amended, leaving Claims 1-7 for further consideration.

Support for the amendments to Claims 1, 2, and 5 can be found in the carryover paragraph of pages 16-17 of Applicants' specification. No new matter has been introduced by these amendments.

Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claim Rejection under 35 USC §103

Claims 1-3, 5, and 6 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,531,073 in view of U.S. Patent Nos. 4,180,740, 5,360,578, and 4,138,361, and WO 01/87801. Applicants respectfully traverse.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The cited references fail to establish a prima facie case of obviousness because the cited references fail to teach or suggest surface treatments that occur after calcining, wherein the surface treatment after calcining using the fluorine containing compound is effective to prevent deliquescence and alteration of the photostimulable phosphor relative to a photostimulable phosphor free of the surface treatment.

The Examiner has combined numerous references with WO 01/87801. However, as noted in previous responses, this reference discloses rendering stone surfaces, such as

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those used in monuments, moisture resistant. Specifically, this reference suggests the use of fluorine compound coatings to provide moisture resistance and water vapor permeability so as to "permit venting of that water which finds its way into the microstructure of the stone.

While it is highly desirable to maximize water repellency, it is also necessary to provide high water vapor permeability in order to permit venting of that water which finds its way into the microstructure of the stone.

(WO 01/878901, page 1, ll. 28-32)

In contrast, Applicants fluorine containing compounds are selected to prevent both deliquescence and alteration of the photostimulable phosphor after calcining. A coating having high water vapor permeability would not be effective to prevent both deliquescence and alteration of the photostimulable phosphor. If the coating is selected to have high water vapor permeability then it is likely water will permeate the phosphor and result in deliquescence and alteration. Even if one of skill in the art were to select a "moisture effective amount" as suggested in the Office Action, the resultant coating would have a high water vapor permeability. Because of this, the teaching and suggestion provided by WO 01/87801, in combination with the other cited references, would fail to provide any reasonable expectation of success.

Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

The secondary considerations also support the conclusion that the present invention is non-obvious. The intractable nature of the problem - i.e., long-felt need and failure to solve - is a strong indicator of non-obviousness. *Shackelton v. J. Kaufman Iron Works, Inc.*, 689 F.2d 334, 217 U.S.P.Q. 98 (2d Cir. 1982), *cert. denied*, 460 U.S. 1052

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(1983). Although the U.S Patent Nos. 4,180,740 and 4,138,361 issued around 1979 and U.S Patent No. 5,360,57 issued around 1994, the problem of making phosphors of the type claimed by Applicants that are not prone to deliquescence and alteration has not been solved until the instant invention.

Accordingly, the rejection is requested to be withdrawn.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

The Examiner is invited to contact Applicants' Attorneys at the below-listed telephone number regarding this Amendment or otherwise regarding the present application.

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If there are any charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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